

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q78432

Hien Boon TAN, et al.

Appln. No.: 10/721,382

Group Art Unit: 2894

Confirmation No.: 6007

Examiner: David E. Graybill

Filed: November 26, 2003

For: HIGH DENSITY CHIP SCALE LEADFRAME PACKAGE AND METHOD OF
MANUFACTURING THE PACKAGE

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits
this Reply Brief in response to the Examiner's Answer dated September 21, 2009. Entry of this
Reply Brief is respectfully requested.

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STATUS OF CLAIMS

Claims 25 and 26 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,825,062 (Yee) and U.S. Patent No. 6,710,430 (Minamio).

Claims 1-24 and 27 have been previously cancelled.

The rejections of claims 25 and 26 are being appealed.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Appellant requests that the following rejections be reviewed:

Claims 25 and 26 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,825,062 (Yee) and U.S. Patent No. 6,710,430 (Minamio).

No other grounds of rejection or objection currently are pending.

This appeal is directed to claims 25 and 26.

ARGUMENT

The rejection of claims 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,825,062 (Yee) and U.S. Patent No. 6,710,430 (Minamio).

Appellant respectfully requests the members of the Board to reverse the aforementioned rejection of claims 25 and 26 under 35 U.S.C. §103(a) as allegedly being unpatentable over Yee in view of Minamio because one skilled in the art would not have combined the teachings of Yee and Minamio to arrive at the claimed invention.

The Examiner has improperly combined features from two separate and distinct embodiments in Yee and then used this improper combination along with Minamio to reject the claims. See for example, *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359 (Fed. Cir. 2008) (unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed). Although the issue is *Net MoneyIN* was anticipation, the same principle would apply to the features of the primary reference in an obviousness context.

Regarding claim 25, the Examiner argues that Yee discloses all of the limitations except for step c), the severing step. However no single embodiment discloses all of the other limitations of the claim. Rather, the Examiner has to rely on two separate and distinct embodiments in Yee. Specifically, the Examiner cites to the third embodiment of figures 3A to 3D plus another embodiment shown in figures 7A to 7D. Not only are these embodiments separate and distinct, they address different objectives. Figures 3A to 3D address the primary and secondary objects of the invention (col. 7, lines 14-17; col. 4, lines 38-52) and figures 7A to 7D address the third and fourth objects of the invention (col. 11, lines 58-62; col. 4, lines 53-60).

More specifically, the Examiner alleges that claim element a) is contained in figures 3A to 3D. The Examiner then alleges that elements b) and d) are contained in figures 7A to 7D. The Examiner does not specifically identify figures 7A to 7D. However, he refers to electrical insulating means 32 as being the claimed adhesive. Item 32 appears only in Figures 7A to 7D and only figures 7A and 7B show a chip connected to a lead portion.

In addition, one of skill in the art would not have been motivated to combine the embodiments of figures 3A to 3D and figures 7A to 7D because they use different structures to achieve the same result. For example, in the figure 3 embodiment, the dimples/apertures 14 are used to prevent lateral motion of the encapsulate lead (col. 9, lines 53-56). Whereas in the figure 7 embodiment, lateral motion is prevented by adhesive attached to the leads (col. 12, lines 40-49).

As a result, even if one were to combine the “severing” feature of Minamio with the Yee embodiments, the combinations would fail to disclose all of the claim limitations. More specifically, if Minamio were combined with the figure 3 embodiment of Yee, at least element b) and d) would be missing. Likewise, if Minamio were combined with the figure 7 embodiment of Yee, at least element a) would be missing.

REPLY BRIEF UNDER 37 C.F.R. § 41.41
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CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



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